

REMARKS

Claims 21 and 26-29 were pending in the present application. Claims 26-29 have been canceled herein without prejudice to their presentation in another application. Claim 21 has been amended herein to correct a typographical error (i.e., missing a dash). No new matter has been added. Upon entry of the present amendment, claim 21 will remain pending.

I. The Claims Are Clear And Definite

Claims 26-29 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Although Applicants disagree with the reasoning stated in the rejection, solely to advance prosecution of the present application, claims 26-29 have been canceled herein, thus rendering the present rejection moot.

II. The Claimed Invention Is Novel

Claims 26-28 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by International Publication WO 01/53266. Although Applicants disagree with the reasoning stated in the rejection, solely to advance prosecution of the present application, claims 26-28 have been canceled herein, thus rendering the present rejection moot.

III. The Claimed Invention Is Not Obvious

Claims 21 and 26-29 are rejected under 35 U.S.C. §103(a) as allegedly being obvious in view of International Publication WO 01/53266 (hereinafter, the “Robertson reference”). As a preliminary matter, claims 26-29 have been canceled herein. The present rejection will, thus, be addressed with respect to claim 21 only. The Office asserts that “TGX-183 is the demethyl homolog of the first cpd. of claim 21” and that “(CHR₃)_n-NR₃-aryl” is an option for the R¹ position of the compound reported in the Robertson reference (see, Office Action at page 3). Applicants traverse the rejection and respectfully request reconsideration because the claimed invention is not obvious in view of the Robertson reference.

The Office fails to make out a *prima facie* case of obviousness in regard to claim 21. The Office asserts that “TGX-183 is the demethyl homolog of the first cpd. of claim 21” and that

“TGX-183 and 186 are highly active in 2 activity tests” (see, Office Action at page 3). When making a *prima facie* case of obviousness, it remains necessary to identify some reason that would have led a person skilled in the art to modify the teachings of a reference in a particular manner. *Takeda Chemical Industries, Ltd. v Alphapharm Pty. Ltd.*, 492 F.3d 1350, 83 USPQ.2d 1169 (Fed. Cir. 2007). No such reasoning has been provided. Indeed, there are many possibilities from which to choose to further modify TGX-183, for example. There is, however, nothing in the Robertson reference to narrow these possibilities to that which is recited in Applicants’ claims. It is only upon examination of Applicants’ specification that such claimed compounds can be rendered obvious. Applicants respectfully point out that “[i]t is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ.2d 1780, 1784 (Fed. Cir. 1992). Indeed, there is no reason provided in the Office Action for further modifying TGX-183 since such compound is “highly active in 2 activity tests.”

Thus, the claimed invention is not obvious in view of the Robertson reference. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

IV. Obviousness-Type Double Patenting

A. U.S. Patent No. 7,405,211

Claims 26-28 are rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 2, and 6-17 of U.S. Patent No. 7,405,211. Although Applicants disagree with the reasoning stated in the rejection, solely to advance prosecution of the present application, claims 26-28 have been canceled herein, thus rendering the present rejection moot.

B. U.S. Patent No. 6,977,255

Claims 21 and 26-29 are rejected under the doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-3 of U.S. Patent No. 6,977,255. Although Applicants disagree with the reasoning stated in the rejection, solely to advance prosecution of

the present application, claims 26-29 have been canceled herein, thus rendering the present rejection moot with respect to the canceled claims. Applicants enclose herewith a Terminal Disclaimer with respect to claim 21. Accordingly, Applicants respectfully submit that the rejection is moot.

V. Conclusion

In view of the foregoing, Applicants respectfully submit that pending claim 21 is in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at 610.610.7859 if there are any questions regarding the present application.

The Commissioner is hereby authorized to debit any fee due or credit any overpayment to deposit account 50-0436.

Respectfully submitted,

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